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CARLSON, GASKEY & OLDS, P.C. 400 WEST MAPLE ROAD SUITE 350 BIRMINGHAM, MI 48009			TORRES, MELANIE	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/915,805

Filing Date: July 26, 2001

Appellant(s): HEATON ET AL.

David J. Gaskey
For Appellant

EXAMINER'S ANSWER

Responsive to the "Order Returning Undocketed Appeal to Examiner" on January 12, 2006, a supplemental Examiner's Answer is set forth below:

Appellant may file another reply brief in compliance with 37 CFR 41.41 within two months of the date of mailing of this supplemental examiner's answer. Extensions of time under 37 CFR 1.136(a) are not applicable to this two month time period. See 37 CFR 41.43(b)-(c).

This is in response to the appeal brief filed January 23, 2006 appealing from the Office action mailed October 7, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

US 6,428,117	Messersmith	8/02
WO 01/05638	Laxhuber et al.	01-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/05638 in view of Messersmith.

Re claim 16-22, WO 01/05638 teaches a vehicle driveline parking brake assembly comprising, a stationary driveline component (17) that remains stationary relative to a portion of the vehicle, a braking member (not shown but disclosed as

connected to 7) associated with a movable driveline component such that the braking member remains stationary relative to the moveable driveline component, an engaging portion (7) associated with the stationary driveline component, the engaging portion selectively movable into a braking position where the engaging portion engages the braking member, a spring (5) that biases the engaging portion into the braking position and an electrically powered actuator (29) having a portion (11) that engages the spring and selectively moves the spring and releases the engaging portion out of the braking position. However, WO 01/05638 does not teach wherein the moveable driveline component comprises a driveline shaft and the braking member comprises a drum that is fixed for rotation on the driveline shaft that is rotatable relative to the stationary driveline component. Messersmith teaches wherein a moveable driveline component (17) comprises a driveline shaft and the braking member comprises a drum (16) that is fixed for rotation on the driveline shaft that is rotatable relative to the stationary driveline component. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the drum assembly of Messersmith in combination with the brake-applying device of WO 01/05638 since parking brakes are well known for use in drum assemblies.

Re claim 20, WO 01/05638 teaches a "duplex cam arrangement"(16) to the same extent as applicant's duplex cam arrangement (40).

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Messersmith.

Re claim 16-22, Messersmith discloses a vehicle driveline parking brake assembly, comprising: a moveable driveline component (17), a stationary driveline component (12) that remains stationary relative to a portion of a vehicle, a braking member (16) associated with the moveable driveline component such that the braking member remains stationary relative to the moveable driveline component, an engaging portion (friction members not numbered) associated with the stationary driveline component, the engaging portion is selectively moveable into a braking position where the engaging portion engages the braking member, a spring (20) that biases the engaging portion into the braking position, an electrically powered actuator (40) having a portion (fluid) that engages the spring and selectively moves the spring and releases the engaging portion out (friction members) of the braking position; and the moveable driveline component comprises a driveline shaft (17) and the braking member comprises a drum (16) that is fixed for rotation on the driveline shaft (17), and that is rotatable relative to the stationary driveline component.

Re claim 20, Messersmith teaches a “duplex cam arrangement”(16) to the same extent as applicant’s duplex cam arrangement (40).

(10) Response to Argument

Applicant argues:

There is no motivation to combine the references as shown in the rejection under 35 USC 103 (a) above. Applicant states that the proposed combination provides no benefit in the Laxhuber reference and, therefore, there is no motivation for making it. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Laxhuber is the base reference. Laxhuber does not teach a brake of any kind – only that a brake can be connected to element 7 for actuation. Messersmith is relied upon for the teaching of brake capable of attachment to element 7 of Laxhuber. It is unclear what applicant means to argue by stating that the combination provides “no benefit” to Laxhuber. Messersmith is not relied upon for teaching a “benefit.” It is relied upon as a teaching that the type of brake shown in Messersmith can be actuated by the lever (7) of Laxhuber’s actuation system. The examiner maintains that it would have been obvious

to combine Laxhuber (which teaches only the actuator that actuates a brake connected to lever 7) with the brake shown in Messersmith.

Applicant also argues that nothing in the reference indicates that it is a “driveline parking brake arrangement.” As combined, the prior art teaches a parking brake arrangement. This is disclosed by Messersmith which calls element 16 a “parking brake” throughout the reference.

With regard to the assembly being for a “driveline.” Clearly, any braking arrangement is connected to the “driveline” of a vehicle since the driveline is what requires braking. Also, Messersmith teaches braking a driveline shaft (17) which is the same as what is applicant discloses. It appears that applicant is attempting to argue that the prior art does not teach a transmission brake. This limitation is simply not claimed, nor is the disclosure limited to transmission brakes since applicant refers to a variety of “driveline brakes” in the background which include conventional parking brakes which use levers and cables.

Applicant also argues that the prior art of record does not teach a “stationary driveline component.” It is unclear what applicant is arguing. There are many “stationary driveline components” along a “driveline” including transmission housings, brake housings, axle housings, actuator housings, etc. Applicant specifically claims a “transmission housing” in claim 18 and an axle assembly in claim 22 as a “stationary driveline component”, therefore, it is clear that a “stationary driveline component” is not limited to a single interpretation. Clearly, the braking components would always be supported on an axle assembly. This is not shown in the prior art but is inherent in a

conventional motor vehicle in which such braking systems are used. In fact the entire vehicle is supported on the axle assemblies. With respect to the component being supported by the transmission housing, brake 16 of Messersmith comprises the same drive shaft 17 of the instant invention and therefore, it would be necessary for the brake to be "partially supported on the transmission" in order to be able to actuate the brake for the drive shaft 17.

Upon further examination of the prior art, it appears that the instant claims are anticipated by Messersmith as rejected in the "NEW GROUNDS OF REJECTION" above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.
This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid **sua sponte dismissal of the appeal** as to the claims subject to the new ground of rejection:

- (1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.
- (2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of

rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

MT *Melanie Torres*
MEANIE TORRES

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Katherine J Malecki
ACTING DIRECTOR
TC 3600

Conferees:

RS - ROBERT SICONOLFI *RS*

XLN - XUAN LAN NGUYEN *XLN*